UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,432	11/25/2003	Virgil A. Albaugh	AUS920030683US1	7145

35525 7590 10/17/2008

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380

EXAMINER	
COLBERT, ELLA	

ART UNIT	PAPER NUMBER
3696	

NOTIFICATION DATE	DELIVERY MODE
10/17/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/721,432	ALBAUGH ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-38 and 54-77* is/are pending in the application.

4a) Of the above claim(s) *16-38 and 54-76* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *77* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 16-38 and claims 54-77 are pending. Claims 16-38 and 54-76 have been withdrawn and claim 77 has been newly added in this communication filed 06/18/08 entered as Response to Non-Final Action.

2. The correspondence Address Change filed 09/09/08 has been entered.

3. The 35 USC 112, second paragraph rejection from the prior Office Action has been overcome and is hereby withdrawn.

4. The 35 USC 101 rejection from the last Office Action has been overcome and is hereby withdrawn.

Claim Objections

Claim 77 is objected to because of the following informalities: Claim 77 is in improper method claim format. Claim 77 recites "responsive to a user ..., ..., using ..., recording ..., ...; responsive to a determination ..., ..., ... ; and transferring the metric ...; wherein ..." . These claim limitations should be written as "consuming the resource of the on-demand service in response to a user, the on-demand service ..., ...; applying a composition rule to the first record to create a metric corresponding to the first record, responsive to a determination that a first record of the plurality of user-specific mettering records ...; and transferring the metric ..., wherein the on-demand service is remote ..., ...". A proper method claim begins with a word ending in "ing" and a comma should be placed before a "wherein" clause. In the sixth line reciting "sensor, recording ... relating to the to user's consumption ...". This line should recite ""sensor, recording ... relating to the user's consumption ...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 77 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 77 recites "sensor" and in the Specification the sections referenced recite "sensors". The Specification describes what the sensors do but not what they are. Are the sensors devices or software applications or signals"?

Also claim 77 recites "user-specific metering records". It is unclear from the Specification, drawings, and claim language what the "user-specific metering records" entail since the Specification recites "specific user's consumption" in paragraph [0038].

Claim 77 further recites "a data gathering agent". It is unclear from the Specification, drawings, and claim language whether the "data gathering agent" is a person, a device, or a piece of software that monitors the consumer's consumption of the resource.

Claim 77 recites "a metering module" and "a processing engine". It is unclear whether these two limitations are software applications or something else.

In addition claim 77 recites "applying a composition rule" and it is unclear what Applicants' mean by a "composition rule" and its connection to the other claim limitations since nothing else is done with "the applied composition rule" after it has been applied to the first record to create a metric".

Claim 77 recites "using the gathering agent, transmitting a packet of usage data ..., the packet ...;" then in the next claim limitation simply recites "the packet". The next claim limitation, in order to have a connection to the prior claim limitation should either recite "receiving the packet of usage data" or "transmitting the packet of usage data to the processing engine".

Also, "to close a unit of work" and "a unit of work identification" do not have anything else being done with them in the other claim limitations once the unit of work is identified nothing is being done with the identification of the unit of work until "an instruction is given to close the unit of work". There is a lack of connection between the claim limitations.

The last claim limitation of claim 77 recites "plurality of records". It is unclear what "plurality of records is being referred to. Do Applicants' mean "plurality of user-specific metering records"?

The claim limitations are lacking in clarity and connecting to each other.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Objections

Claim 59 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 69. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 77 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 77. Claim 77 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In many instances it is clear within which of the enumerated categories a claimed invention falls. The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- but rather on the essential characteristics of the subject matter, in particular, its practical utility. In the instant invention, the claimed subject matter does not cover either a 101 judicial exception or a practical application of a 101 judicial exception. The claimed subject matter is merely directed towards an abstract idea. While a scientific truth, or mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge or scientific truth may be. *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the

abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right". *Le Roy*, 55 U.S. (14 How.) at 175.

To further clarify, in order for a method to be considered a "process" under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements are met by the claim, the method is not a patent eligible process under § 101, and is non-statutory subject matter. An example of a method claim that would not Qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Denner*, 94 U.S. 780, 787-88 (1876).

It cannot be determined from the clam language, the Specification, and Drawings whether Applicant's "sensor(s)" are a device or signal. It is not sufficient to have computer-implemented in the preamble. There is a requirement to have an apparatus in the body of the claim to perform the method steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over "XACCT Technologies Enables Usage-based Billing for Internet; NSPs Can Now 'Right-Price' IP-Based Applications", hereafter XACCT in view of (US 6,338,046) Saari et al, hereafter Saari.

Claim 77. XACCT discloses, A computer implemented method for processing a plurality of records into a metric to measure a user's consumption of a resource of an on-demand service, the computer implemented method comprising:

responsive to a user consuming the resource of the on-demand service, the on-demand service comprising a sensor, a data gathering agent, and a metering data consumer, using the sensor, recording usage data relating to the to user's consumption of the resource (Pg. 1, para. 2, para. 5, and para. 7); using the data gathering agent, receiving the usage data from the sensor and storing the usage data as a plurality of user-specific metering records, each of the plurality of user-specific metering records comprising a resource identification, a user identification, a resource measurement value, and a unit of work identification (Pg. 1, para.'s 9 and 10); using the data gathering agent,

transmitting a packet of usage data to a metering module, the packet comprising the plurality of user-specific metering records, the metering module comprising a web services interface and a processing engine (Pg. 2, para. 's 4 & 5 and Pg. 3, para's 3-5); XACCT failed to disclose, using the web services interface, receiving the packet and transmitting the packet to the processing engine. Saari discloses, using the web services interface, receiving the packet and transmitting the packet to the processing engine (col. 10, line 43-col. 11, line 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Saari in XACCT because such an incorporation would allow XACCT to transmit packets of information (files) and to manage complex traffic effectively as the packets move from being received to transmission and processing.

XACCT further discloses, using the processing engine storing the plurality of user-specific metering records in a database (Pg. 3, para. 5); responsive to a determination that a first record of the plurality of user-specific metering records contains an instruction to close a unit of work and using the processing engine, applying a composition rule to the first record to create a metric corresponding to the first record (Pg. 2, para. 6); using the processing engine, storing the metric in the database, wherein the metric is stored in the database in the same format as the plurality of user-specific metering records (Pg. 3, para. 6) ; and transferring the metric to the metering data consumer (Pg. 2, para. 9-16 –Pg. 2, para. 1); wherein the on-demand service is remote from the metering module, communicates with the metering module via the web

services interface, and the plurality of records are processed into the metric to measure the user's consumption of the resource of the on-demand service (Pg. 3, para. 7).

Response to Arguments

Applicants' arguments with respect to claims 1-15 and 39-53 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.

The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

October 14, 2008